

Remarks

Upon entry of the above amendments, this application will contain claims 1-3, 5-8, 10-14, 17, 21, and 29-31 pending and under consideration. Claims 4, 9, 15-16, 18-20, and 22-23 were canceled in prior responses. In the present Response, claims 24-28 have been canceled and new claim 31 has been added. Claims 1, 2, and 14 have been amended. As discussed more fully below, it is believed that the application is in condition for allowance. Prompt reconsideration leading to withdrawal of all rejections is requested.

I. Election/Restriction

The withdrawal of the restriction requirement in light of the amended claims is gratefully acknowledged.

II. Rejections under 35 USC §112, first paragraph

Claims 1-3, 5-8, 10-13, 17, 21 and 24-30 were rejected under 35 USC §112, first paragraph. It was noted that the amendments to the definitions to R⁵ in claim 1 includes a cyano moiety that was not described in the specification. Applicants maintain that the application is not deficient for lack of written description see Example 9 in the present application. However, in order to advance the prosecution of this application, claim 1 has been amended by deleting reference to the cyano variable for the R⁵ substituent.

In light of the above comments and claim amendments, withdrawal of the rejections of claims 1-3, 5-8, 10-13, 17, 21 and 29, and 30 is requested. Claims 24-28 have been canceled.

III. Rejections under 35 USC §112, second paragraph

1) Claims 24, 26-28 were rejected under 35 USC §112 first paragraph for failing to comply with the enablement requirement. Applicants maintain that the present application is not deficient for lack of enablement. However in order to advance the prosecution these claims have been canceled.

In light of the above comments and claim amendments, withdrawal of the rejections of claims 24, 26-28 is requested.

In addition it should be noted that claim 25, which was not rejected but depended from canceled claim 24, has also been canceled. New claim 31 has been submitted. New claim 31 includes the subject matter of both claims 24 and 25. It is believed that this new claim does not add new matter and that this new claim is patentable.

2) Claims 1-3, 5-8, 10-14, 17, 21, and 24-30 were rejected under 35 USC §112, second paragraph for failing to particularly point out and distinctly claim the subject matter that inventors regard as their invention. Specifically it was noted that:

a) In claim 1 and its dependence claims, the moiety R^6 is not defined. The figure in claim 1 has been amended by removing reference to the R^6 variable. It is believed that this amendment does not add new matter and is fully supported by the specification. In each of the Examples 1-15 the moiety “ $-(CHR^6)_n-$ ” reduces to a bond between the nitrogen and K with $n = 0$. Consequently, withdrawal of this rejection for claim 1 and its dependent claims is requested.

b) In claim 1 and its dependence claims, the moiety “O” for the W, X, Y, and Z variables was considered indefinite in light of the prior amendments where the “A” ring was defined as pyridine, thiophene, or pyrazole. Claim 1 has been amended by deleting reference to “O”. It is believed that this amendment overcomes the rejection and does not add new matter.

c) In claim 2 the variables for R1 were not presented in the proper Markush format. Claim 2 has been amended to recite that R1 is either a $-C_1-C_6$ alkyl or $-OC_1-C_6$ alkyl.

d) In claim 14 the compound: “8-[Acetyl-(3,5-bis-trifluoromethyl-benzyl)-amino]-3-methyl-5,6,7,8-tetrahydro-thieno[3,2-b]azepine-4-carboxylic acid isopropyl ester” was entered twice. The first occurrence of this compound on lines 22-23 has been removed.

e) In claim 14, the 23rd and 24th entries were considered vague because of missing parentheses. These entries have been deleted.

In light of the above comments and claim amendments, withdrawal of all rejections of claims 1-3, 5-8, 10-14, 17, 21, and 29-30 is requested. Claims 24-28 have been canceled.

VI. Conclusion

In light of the above claim amendments and comments withdrawal of all rejections is requested. Applicants respectfully request timely reconsideration of this application leading to allowance of all pending claims. The Examiner is invited to contact the undersigned attorney by telephone if there are any questions about this Response or other issues that may be resolved in that fashion.

Eli Lilly and Company
Patent Division
P.O. Box 6288
Indianapolis, Indiana 46206-6288
Phone: 317-276-0755
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Respectfully submitted,
/James B. Myers/
James B. Myers
Attorney for Applicants
Registration No. 42,021